

Remarks

Claims 1-5 inclusive, 10 and 12 remain.

In the Final Rejection claims 1-3 have been rejected under 35 USC §102(e) as being anticipated by Butt et al (US Pat. No. 7,031,104 B1).

The Examiner has correctly cited Butt as an anticipating reference to claims 1-3 because Butt teaches a plurality of “discrete surface features arranged in a pattern of radially-spaced concentric rings” (item 108 in Fig. 5B), “each ring” (item 70b in Fig. 4B) “comprising a plurality of discrete spaced-apart surface features” (items 84 and 88 in Fig. 4B). Applicants were aware of Butt and clearly intended to distinguish the continuous channels of Butt (see Fig. 5B) by reciting the discrete surface features in the rings (see Applicants’ Fig. 6A). Applicants believed that the phrase “discrete surface features arranged in ... rings”, with “each ring comprising a plurality of discrete spaced-apart surface features” clearly stated that the surface features were spaced-apart in a *circumferential direction* because the features were *within the rings*, and of course “rings” are inherently circumferentially directed. However, Applicants did not consider the Examiner’s interpretation of Butt, wherein the two rims (84, 88) of each individual channel (70b) can be considered to be surface features that are *radially* spaced-apart.

In a telephone interview with the Examiner on 10/18/2006, Applicants’ attorney proposed the addition of the word “circumferential” to independent claims 1 and 4, as now presented in this amendment. The Examiner indicated she would not entertain this amendment because it could have been presented earlier and it would be a mere “relocation of parts”.

First, this is not a *new* argument that could have been presented earlier. Applicants clearly intended that the previous amendment would limit the surface features to being *circumferentially* spaced-apart. This is apparent by the several references in the previous amendment that the amended claims were directed to the embodiment shown in Fig. 6A. Unfortunately, Applicants’ attorney failed to appreciate the Examiner’s ingenious

interpretation of Butt wherein the two *radially* spaced-apart rims of each Butt channel could be construed as discrete surface features within the channel.

Secondly, the amendment is not a mere relocation of parts because the function of the Butt “surface features” is substantially different from the function of Applicants’ surface features. The function of the *continuous* channels of Butt is to encourage the turbulent flow caused by the actuator arm to become laminar. The function of the discrete *radially and circumferentially spaced-apart* surface features in Applicants’ invention is to reduce viscous shear forces *while maintaining existing laminar flow*.

Thus Applicants respectively request reconsideration of this amendment. Applicants should not have to bear the cost and delay in filing a Request for Continued Examination merely because Applicants’ attorney failed to add the word “circumferentially”, which he mistakenly believed was inherent in the word “rings”.

The Examiner may call Applicants’ attorney if a telephone conference will expedite the prosecution of this application.

October 20, 2006

Respectfully submitted,

/ **Thomas R. Berthold** /

Thomas R. Berthold, Attorney for Applicants
Reg. No. 28,689
18938 Congress Junction Ct.
Saratoga, CA 95070-4570
Phone: (408) 396-8411
Fax: (408) 904-6605